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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Henkel S.P.A.

Serial No. 78293275

Jane T. Collen of Collen IP for Henkel S.P.A.

Katherine Stoides, Trademark Examining Attorney, Law Office
101 (Ronald R. Sussman, Managing Attorney).

Before Walters, Rogers and Drost, Administrative Trademark
Judges.

Opinion by Drost, Administrative Trademark Judge:

Applicant Henkel S.P.A. applied to register the mark
MORRIS (in typed or standard character form), on the
Principal Register for goods ultimately identified as
"shoes, slippers and boots; clothing, namely, tuxedos,
suits, waistcoats, jackets, trousers, skirts, shirts,
blouses, coats, overcoats, raincoats, t-shirts, sweaters,
polo neck and button-neck sweaters, cardigans, shorts,
blue-jeans, anoraks; neckties, foulards, scarves; belts;
hats, caps; articles of clothing made of leather, namely
jackets, trousers, overcoats, waistcoats all aforementioned

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goods not used in connection with golf or golf-related apparel; gloves, excluding hunting gloves and golf gloves" in Class 25.¹

The examining attorney refused to register applicant's mark under Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), because of two registrations owned by different parties. The first registration² is for the mark TOM MORRIS (in typed or standard character form) for "clothing; namely, shirts, sweaters, vests, suits, pants, hats, socks, shoes, belts, wristbands, ties, gloves, rainwear, scarves and shawls" in Class 25.³

The second registration⁴ is on the Supplemental Register for the mark:

MORRIS
Feel Gloves

¹ Serial No. 78293275, filed August 28, 2003, is based on applicant's assertion of a bona fide intention to use the mark in commerce.

² No. 1,835,884 issued May 10, 1994, Renewed. Tom Morris Limited is the listed owner.

³ The registration also includes the following goods in Class 28: "golf equipment; namely, golf clubs, golf balls, golf ball markers, golf bags, head covers for golf clubs and golf tees."

⁴ No. 555,769 issued March 4, 1952, Third Renewal. Boss Manufacturing Company is identified as the current owner.

for "woolen and cotton hunting gloves" in Class 25.

After the examining attorney made the refusals final, this appeal followed.

In likelihood of confusion cases, we analyze the facts as they relate to the factors set out in In re Majestic Distilling Co., 315 F.3d 1311, 65 USPQ2d 1201, 1203 (Fed. Cir. 2003). See also In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 567 (CCPA 1973); Recot, Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1896 (Fed. Cir. 2000).

Two factors that are often critical in likelihood of confusion determinations are the similarities of the mark and the relatedness of the goods. Regarding the goods in Registration No. 1,835,844, they are identical to applicant's goods inasmuch as the registration and application both include shirts, sweaters, suits, hats, shoes, and belts. The goods are also overlapping. The registered mark includes shirts, pants, sweaters, ties, gloves, and rainwear. Applicant seeks registration for essentially the same goods: trousers (pants), raincoats (rainwear), t-shirts (shirts), polo neck and button-neck sweaters (sweaters), cardigans (sweaters), blue jeans (pants), neckties (ties), and gloves, excluding hunting gloves and golf gloves (gloves). We are aware that

applicant has included the following limitation in its identification of goods "all aforementioned goods not used in connection with golf or golf-related apparel." Even if we assume that this limitation applied to all the previously listed goods, we must nonetheless conclude that the goods are identical to the extent that registrant's goods are not limited to golf-related clothing.⁵ Because registrant's goods are not limited, we must read the identification of the goods to include clothing items that are not used in connection with golf or golf-related apparel. Therefore, registrant's and applicant's goods are, in part, identical and overlapping goods.

"When marks would appear on virtually identical goods or services, the degree of similarity necessary to support a conclusion of likely confusion declines." Century 21 Real Estate Corp. v. Century Life of America, 970 F.2d 874, 23 USPQ2d 1698, 1701 (Fed. Cir. 1992). In addition, when goods are identical, we must also consider that the goods move in identical channels of trade and that the purchasers

⁵ Normally, we would read the phrase as only limiting the goods before the semicolon, i.e., articles of clothing made of leather, namely jackets, trousers, overcoats, waistcoats all aforementioned goods not used in connection with golf or golf-related apparel." Also, inasmuch as diverse clothing is worn while playing golf on public and private courses, we are not clear how shirts, shorts, and similar items "not used in connection with golf" differ from shirts or shorts used in connection with golf.

are identical. Schieffelin & Co. v. Molson Companies Ltd., 9 USPQ2d 2069, 2073 (TTAB 1989) ("Moreover, since there are no restrictions with respect to channels of trade in either applicant's application or opposer's registrations, we must assume that the respective products travel in all normal channels of trade for those alcoholic beverages"); In re Smith and Mehaffey, 31 USPQ2d 1531, 1532 (TTAB 1994) ("Because the goods are legally identical, they must be presumed to travel in the same channels of trade, and be sold to the same class of purchasers").

Therefore, we cannot rely on applicant's Internet printout showing what is apparently registrant's current marketing operation to limit the scope of its registration. Furthermore, applicant's argument (Brief at 4) that registrant's unrestricted goods "are specifically golf related, sold through and targeted at a specific audience in a specific industry" because of applicant's evidence of how registrant is actually using its mark is at odds with long-established precedent in trademark cases.

The authority is legion that the question of registrability of an applicant's mark must be decided on the basis of the identification of goods set forth in the application regardless of what the record may reveal as to the particular nature of an applicant's goods, the particular channels of trade or the class of purchasers to which the sales of goods are directed.

Octocom Systems, Inc. v. Houston Computers Services Inc., 918 F.2d 937, 16 USPQ2d 1783, 1787 (Fed. Cir. 1990). See also Paula Payne Products v. Johnson Publishing Co., 473 F.2d 901, 177 USPQ 76, 77 (CCPA 1973) ("Trademark cases involving the issue of likelihood of confusion must be decided on the basis of the respective descriptions of goods").

Also, while applicant argues (Reply Brief at 3) that there is no evidence that Tom Morris Limited "has ever been inclined to expand into the general apparel or fashion industries," we point out that this is not a case of the registrant expanding the use of its mark on a different, but related, item. Rather this case involves a registrant who has a registration for its mark on the identical goods. As discussed above, we cannot limit the registered mark to any particular type of clothing item beyond what is set out in the registration. However, applicant is not without a remedy if it believes that there would be no likelihood of confusion if the identifications of the parties' goods were restricted. Applicant may file a petition to cancel under the provision of Section 18 of the Trademark Act. 15 U.S.C. § 1068 ("In such proceedings the Director may refuse to register the opposed mark, may cancel the registration, in whole or in part, may modify the application or

registration by limiting the goods or services specified therein...").

Next, we compare the similarities and dissimilarities of the marks, TOM MORRIS and MORRIS. It is clear that the marks are identical to the extent that they both contain the word MORRIS and they are different because registrant's mark adds the given name TOM. The examining attorney cites two cases in which there was a likelihood of confusion when one party's mark is a surname and the other mark is the surname with a given name. See In re Sawyer of Napa Inc., 222 USPQ 923 (TTAB 1983) (SAWYER and TOM SAWYER held to be similar); and Modern Shoe Co. v. B.B. Walker Shoe Co., 170 USPQ 530, 531 (TTAB 1971) ("'WALKER' and 'JOHNNIE WALKER' could be regarded as one and the same individual. These names when used as marks will create the same impression and such impression is greatly enhanced because they are used on directly competitive goods, even as to price").

The Modern Shoe case also noted that "it is not uncommon to identify an individual by a surname without reference to a first or Christian name, for example Nixon or Rockefeller in reference to well-known political figures." Id. More recently, the Federal Circuit discussed the question of likelihood of confusion when applicant sought registration of the mark JOSE GASPAR GOLD

and registration was refused because of a registration for the mark GASPAR'S ALE. The court explained:

With respect to JOSE, the Board correctly observed that the term simply reinforces the impression that GASPAR is an individual's name. Thus, in accord with considerable case law, the JOSE term does not alter the commercial impression of the mark. See E & J Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1291-92 (9th Cir. 1992) (affirming that GALLO and JOSEPH GALLO are similar); Nina Ricci, S.A.R.L. v. E.T.F. Enters., Inc., 889 F.2d 1070, 1073-74 (Fed. Cir. 1989) (holding that VITTORIO RICCI and NINA RICCI are similar); John B. Stetson Co. v. Stephen L. Stetson Co., 85 F.2d 586, 587 (2d Cir. 1936) (holding that STEPHEN L. STETSON and STETSON are similar); but see Brennan's Inc. v. Brennan's Rest., L.L.C., 360 F.3d 125, 133 (2d Cir. 2004) (explaining that BRENNAN'S and TERRANCE BRENNAN'S are not similar because "the addition of the first name 'Terrance' to defendant's mark is meaningful"). In sum, the first name JOSE modifies the surname GASPAR and serves to emphasize that GASPAR is a name.

In re Chatham International Inc., 380 F.3d 1340, 71 USPQ2d 1944, 1946 (Fed. Cir. 2004).

Similarly, when considered in their entirety, TOM MORRIS and MORRIS both emphasize the same term, "Morris." Obviously, "Morris" is the only term in applicant's mark and the term "Tom" likewise points to the surname "Morris." Therefore, we conclude that the marks' similarities in sound, appearance, meaning, and commercial impression outweigh their differences.

When we consider that the marks TOM MORRIS and MORRIS are intended to be used on identical and overlapping goods,

confusion would be likely in this situation. Therefore, we affirm the examining attorney's refusal to register based on Registration No. 1,835,884.

We next look at the refusal based on Registration No. 555,769. Again, we begin by comparing the goods. Applicant's goods include gloves, excluding hunting gloves and golf gloves, as well as various clothing items. Registrant's goods are woolen and cotton hunting gloves. Unlike the situation with the goods in Registration No. 1,835,884, applicant has eliminated the identical goods that are in Registration No. 555,769 from its identification of goods. Therefore, the goods here are not identical or overlapping. However, while not identical, it is clear that both identifications include different types of gloves. More importantly, regarding the other items, the examining attorney argues (Brief at 10) that "applicant's wearing apparel, identified in broad terms, is presumed to include items of clothing that are suitable for hunting or are likely to be worn by those engaged in hunting." The examining attorney has included several registrations to support its argument (Final Office Action at 3) that "[c]ustomers are accustomed to encountering hunting equipment along with wearing apparel in general or sportswear specifically." See, e.g., Registration No.

2,893,507 (clothing and hunting and fishing vests); No. 2,898,894 (clothing and hunting safety harness); and No. 2,876,960 (clothing and hunting camouflage).

The examining attorney argues (Brief at 11) that "applicant's items of wearing apparel are presumably suitable for use by hunters and are therefore potentially complementary goods to the registrant's hunting gloves." We agree that there is nothing that limits many of applicant's goods from being used for hunting purposes. Applicant points out (Brief at 5) that "hunter consumers are unlikely to dress in items such as waistcoats, trousers and leather jackets in addition to hunting gloves when participating in any hunting season." However, applicant's goods also include shirts, jackets, coats, anoraks, hats, and caps and these items could be a type that is worn while hunting. We agree with the examining attorney that registrant's hunting gloves would be related to applicant's shirts, hats, and similar items.

Furthermore, we cannot agree with applicant's arguments (Reply Brief at 4) that the goods travel in different channels of trade or that the "likelihood that a single group will encounter and be confused by the parties' trademarks is unlikely." As we explained, applicant's goods would include clothing items such as shirts, jackets

and hats that could be worn for hunting and these items may clearly be found not just in the same general retail stores but also in the same section of these stores. The same customers in the same trip to the store could, therefore, encounter goods with applicant's and registrant's mark and assume that they originate from the same or an associated source.

In order to find that there is a likelihood of confusion, it is not necessary that the goods or services on or in connection with which the marks are used be identical or even competitive. It is enough if there is a relationship between them such that persons encountering them under their respective marks are likely to assume that they originate at the same source or that there is some association between their sources.

McDonald's Corp. v. McKinley, 13 USPQ2d 1895, 1898 (TTAB 1989). See also In re Opus One Inc., 60 USPQ2d 1812, 1814-15 (TTAB 2001). There is also no evidence for us to conclude that these goods "are purchased after careful consideration and comparison" as applicant asserts. Brief at 6.

Next, we compare the similarities and dissimilarities of the marks. The marks MORRIS and MORRIS FEEL GLOVES are similar to the extent that both begin with the identical term MORRIS. They are different in that registrant's mark is depicted in stylized form and it also includes the descriptive words "Feel Gloves." The fact that

registrant's mark is shown in stylized form is not legally significant because applicant's mark is not limited to any particular style. Squirtco v. Tomy Corp., 697 F.2d 1038, 216 USPQ 937, 939 (Fed. Cir. 1983) ("[T]he argument concerning a difference in type style is not viable where one party asserts rights in no particular display. By presenting its mark merely in a typed drawing, a *difference* cannot legally be asserted by that party. Tomy asserts rights in SQUIRT SQUAD regardless of type styles, proportions, or other possible variations. Thus, apart from the background design, the displays must be considered the same").

Next, we look at the additional language in registrant's mark "Feel Gloves." Inasmuch as the mark is registered on the Supplemental Register, we can assume that this terminology is merely descriptive, or in the case of the term "gloves" for "gloves," generic.⁶ In re Consolidated Foods Corp., 200 USPQ 477, 478 n.2 (TTAB 1978) ("Registration of the same mark on the Supplemental register is not prima facie evidence of distinctiveness; in fact, such a registration is an admission of descriptiveness"). See also Quaker State Oil Refining

⁶ "Morris" was likely considered to be a surname and, therefore, registrable on the Supplemental Register.

Corp. v. Quaker Oil Corp., 453 F.2d 1296, 172 USPQ 361, 363 (CCPA 1972). Because of the descriptive nature of these terms, they are less likely to be as important in distinguishing the marks as the name "Morris." Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1845-45 (Fed. Cir. 2000) (citations and quotation marks omitted) ("[B]ecause both marks begin with 'laser,' they have consequent similarities in appearance and pronunciation. Second, the term 'swing' is both common and descriptive... Regarding descriptive terms this court has noted that the descriptive component of a mark may be given little weight in reaching a conclusion on likelihood of confusion").

Similarly here, both marks begin with the identical word, the surname "Morris." Registrant then adds the term "Feel Gloves" for its hunting gloves. The marks sound and look similar inasmuch as their initial term "Morris" is identical and the additional descriptive wording in registrant's mark would not distinguish the marks. Furthermore, their commercial impressions and meanings would likewise be similar because of the dominance of the common word "Morris." While we do not ignore the additional wording in registrant's mark, it would be unlikely that customers would rely on this wording to distinguish the marks. Also, the marks are not used on

identical products and it would be expected that the owner of the mark for MORRIS FEEL GLOVES would discontinue the use of the words "Feel Gloves" if it used the mark on related clothing items that were not gloves. Under these circumstances, when prospective purchasers of hunting clothing who are familiar with registrant's MORRIS FEEL GLOVES for hunting gloves encounter the mark MORRIS for hunting shirts and jackets, they are likely to assume that the goods come from a common source. Therefore, we hold that there is also a likelihood of confusion regarding the mark and goods in Registration No. 555,769 and the mark for which applicant seeks registration.

Applicant also points out (Brief at 2) that the "marks TOM MORRIS for clothing and golf equipment and MORRIS FEEL GLOVES for hunting gloves are both registered in the same class by two unrelated parties; however they continue to co-exist in the market place without likelihood of confusion." However, even if these two registrations were confusingly similar, these registrations cannot be used to justify the registration of another confusingly similar mark. In re J.M. Originals Inc., 6 USPQ2d 1393, 1394 (TTAB 1987). Furthermore, in this case the differences between the marks TOM MORRIS and MORRIS FEEL GLOVES is greater than in the instant case. Therefore, the existence of these two

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registrations does not indicate that confusion is unlikely when the marks MORRIS and TOM MORRIS and MORRIS and MORRIS FEEL GLOVES are used on the identified goods.

Decision: The refusals to register applicant's mark in view of Registration Nos. 555,769 and 1,835,884 under Section 2(d) are affirmed.